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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER

ART UNIT

PAPER NUMBER

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/220,691

Applicant(s)
Tsuji et al.

Examiner
JON P. WEBER, Ph.D.

Group Art Unit
1651



X Responsive to communication(s) filed on 16 Jun 2000

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11, 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

- X Claim(s) 1-4 and 6-21 is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- Claim(s) _____ is/are allowed.
- X Claim(s) 1-4 and 6-21 is/are rejected.
- Claim(s) _____ is/are objected to.
- Claims _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- X Notice of References Cited, PTO-892
- X Information Disclosure Statement(s), PTO-1449, Paper No(s). 4
- Interview Summary, PTO-413
- Notice of Draftsperson's Patent Drawing Review, PTO-948
- Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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Status of the Claims

Claims 1-4 and 6-21 have now been presented for examination.

The response with amendments filed 16 June 2000 has been received and entered.

Claim Rejections - 35 USC § 112

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Claim 2 is rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

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Claim 2 recites that the instantly claimed process is performed with inhibitors of elastase-like enzymes which are not inhibitors of metalloproteases. However, Tsuji et al. (JP 10265359) establish that the same set of inhibitors disclosed herein are in fact inhibitors of metalloproteases and can be used to provide excellent controlling action on wrinkle formation. The structures of the relevant compounds are set forth, for example, at pages 2 and 4 of Tsuji et al. (JP 10265359).

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Consequently, the instant disclosure does not provide any inhibitors of elastase-like enzymes which are not inhibitors of metalloproteases which may be used in the claimed process.

Claims 7-21 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 7, at line 3 recites "phosphoric acid derivatives" which is confusing because the structure subsequently presented is a "phosphonic acid derivatives". Perhaps this is simply a misspelling.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-4 are rejected under 35 U.S.C. 102(e) as being anticipated by Styczynski et al. (US 5,962,466).

Styczynski et al. (US 5,962,466) disclose that inhibitors of metalloproteases can be used to reduce unwanted hair growth by administration to the area in need thereof. A range of possible inhibitors are set forth at column 2, lines 10-59. As evidence that inhibitors of metalloproteases are encompassed by instant claims 1-4 and disclosure, Norcini et al. (WO 97/19102) and Erion et al. (US 5,155,100) are offered to show that the same compounds disclosed as useful in the instantly claimed process (instant claims 7-21) are themselves inhibitors of metalloproteases.

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Claims 1-4 and 6-21 are provisionally rejected under 35 U.S.C. 102(a) as being anticipated by Tsuji et al. (JP 10265359) pending perfection of the instant Japanese priority document and a showing therein that the instantly claimed invention is adequately supported.

5 Tsuji et al. (JP 10265359) disclose that the same set of inhibitors disclosed herein can be used to provide excellent controlling action on wrinkle formation. The structures of the relevant compounds are set forth, for example, at pages 2 and 4 of Tsuji et al. (JP 10265359). The action of the inhibitors is to inhibit metal-dependent elastin-decomposing enzymes. A composition comprising the inhibitors is formulated for topical application to the skin. Although the formulation is for controlling wrinkle formation, administration to the skin would inherently
10 control the growth of hair at the site of administration.

No claims are allowed.

15 Any inquiry concerning this communication should be directed to Jon P. Weber, Ph.D. at telephone number (703) 308-4015. The examiner can normally be reached during the hours of 07:30 to 17:30 Eastern (off first Friday).

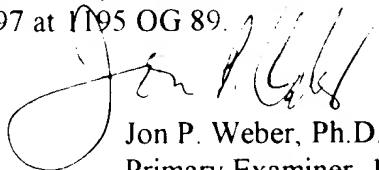
20 If attempts to reach the examiner by telephone are unsuccessful, a message may be left on the voice mail. The fax number for Art Unit 1651 is (703) 308-4242 or 305-3014. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196. My supervisor, Michael Wityshyn, may be contacted at (703) 308-4743.

25 All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified or exchanged unless there is of record an express waiver of the confidentiality requirements of 35 U.S.C. 122 by

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the applicant. See the Interim Internet Usage Policy published in the Patent and Trademark Office
Official Gazette on 25 February 1997 at 1195 OG 89.
J.P.W. 31 July 2000

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Jon P. Weber, Ph.D.
Primary Examiner, 1651
jon.weber@uspto.gov